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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,519	03/12/2001	Shinya Haraguchi	7217/64041	1959

7590 05/04/2004

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EXAMINER

EDWARDS, ANTHONY Q

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,519

Applicant(s)

HARAGUCHI ET AL.

Examiner

Anthony Q. Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8-10 and 12 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,594,619 to Miyagawa et al. Referring to claim 1, Fig. 34 of Miyagawa et al. shows a portable information terminal including an upper half portion (95) having a screen-arranged surface, wherein a display screen (105) of a display device is disposed at the screen-arranged surface, a lower half portion (93) including an input key array of a plurality of input keys arranged on a key-arranged surface thereof. Fig. 31 shows a controller (161), inherently provided in the lower half portion, the controller (161) analyzes an operating instruction input through the input keys and carries out the control processing corresponding to an analysis result to reflect the analysis result to the display content of the display screen (see col. 15, lines 17-22).

Likewise, Miyagawa et al. disclose a joint unit (163, 165, 167) for joining the respective end sides of the upper and lower half portions to each other so that the upper and lower half portions are rotatable around a first rotational axis so that in a first state the screen-arranged surface of said upper half portion on which the display screen is disposed can face and overlay the key-arranged surface side of the lower half portion on which the plural input keys are disposed (see Fig. 36 and the corresponding specification), and so that the upper half portion is rotatable around a second rotational axis perpendicular to the first rotational axis at the joint

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portion between the upper half portion and the lower half portion, whereby in a second state the back surface of the upper half portion can face and overlay the key-arranged surface of the lower half portion (see Fig. 35 and the corresponding specification).

Lastly, Miyagawa et al. disclose a detection unit (see col. 15, lines 25-30) for detecting whether the portable information terminal is in the first state in which the display screen of the upper half portion faces the key-arranged surface side of the lower half portion or in the second state in which the back surface of the upper half portion faces the key-arranged surface side, wherein the controller (161) controls the control processing in accordance with the detection result supplied from said detecting unit. See col. 15, lines 17-31.

Referring to claim 5, Miyagawa et al. disclose a portable information terminal as claimed, wherein the controller (139) controls the display content of the display screen in accordance with the detection result supplied from the detecting unit, so that an image on the display screen is rotated by 180 degrees. See Fig. 33 and col. 16, lines 1-5.

Referring to claim 8, Miyagawa et al. disclose a portable information terminal as claimed, further comprising an operating unit (e.g., switch) for carrying out the control operation of the display content of said display screen, wherein the operating unit is provided to the upper half portion and/or said lower half portion so as to be exposed to the outside when the upper half portion overlays the lower half portion, and the controller (161) analyzes an operating instruction input through the input keys or the operating unit to perform the control processing corresponding to the analysis result and reflect the control processing result to the display content of the display screen (see col. 15, lines 31-38).

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Referring to claim 12, Miyagawa et al. disclose a portable information terminal, further comprising a key operating unit which is functionally varied between said first state and said second state. See the “specific key” recited in col. 15, lines 31-35.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa et al. in view of U.S. Patent No. 6,522,879 to Myer et al., and further in view of U.S. Patent No. 6,494,974 to Nobuchi et al. Referring to claim 9, Miyagawa et al. disclose the invention as claimed, except for (1) comprising a radio transmission/reception unit for transmitting/receiving a message in a wireless mode, and (2) wherein a message to be transmitted is written onto the display screen by using the plurality of input keys only when the screen-arranged surface of the upper half portion and the key-arranged surface of the lower half portion can be visually recognized by a user who writes the message.

Myer et al. disclose a radio transmission/reception unit for transmitting/receiving a message in a wireless mode, which includes a two-way telephone and two-way paging service on the same wireless infrastructure. See Fig. 4 and the corresponding specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

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portable information terminal of Miyagawa et al. to provide wireless telephone and paging capability as taught by Myer et al., to have greater mobility of the portable device.

Likewise, Nobuchi et al. disclose a portable information processing apparatus having a control unit or switching mechanism (10), a sensor switch (30), and a locking device, which combine to effect the operability of keys, such that a message to be transmitted is written onto the display screen by using the input keys only when the screen-arranged surface of said upper half portion and the key-arranged surface of the lower half portion can be visually recognized by a user who writes the message. See Figs. 1, 2 and col. 8, lines 1-10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the portable information terminal of Miyagawa et al. to only transmit a message on the display screen while the key-arranged portion and the display portion are visually recognized by the user by limiting the use of keys, as taught Nobuchi et al., since the locking device of Nobuchi et al. would prevent a user from inadvertently depressing keys in a certain mode.

Referring to claim 10, Miyagawa et al. disclose the invention as claimed, except for (1) further comprising a radio transmission/reception unit for transmitting/receiving a message in a radio mode, and (2) wherein under a second state that the back surface of the upper half portion faces the key-arranged surface side of said lower half portion, the controller neglects a character input based on one of the plurality of input keys.

Myer et al. disclose a radio transmission/reception unit for transmitting/receiving a message in a radio mode, which includes a two-way telephone and two-way paging service on the same wireless infrastructure. See Fig. 4 and the corresponding specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

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portable information terminal of Miyagawa et al. to provide paging capability as taught by Myer et al., to have greater flexibility and mobility of the portable device.

Likewise, Nobuchi et al. disclose a portable information processing apparatus having a control unit or switching mechanism (10), a sensor switch (30) and a locking device, which combine to effect the operability of keys, such that under the state in which the back surface of the said upper half portion faces the key-arranged surface side of the said lower half portion (see Fig. 2 of Nobuchi), the controller neglects a character input even when there is character input based on the input key. See col. 5, lines 5-12 and col. 8, lines 1-10 of Nobuchi. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the portable information terminal of Miyagawa et al. to prevent a character input even when there is character input based on the input key by the user by limiting the use of keys, as taught Nobuchi et al., since the locking device of Nobuchi et al. would prevent a user from inadvertently depressing keys in a certain mode.

Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reasons for allowance were provided in the previous Office Action.

Response to Arguments

Applicant's arguments filed February 23, 2004 have been fully considered but they are not persuasive. Referring to claim 1, applicant argues on page 8 that "Miyagawa et al. does not

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disclose any controller being connected to any such unknown mechanism for detecting rotation of the display device.” Examiner disagrees since, as indicated in the above rejection, it is taught in col. 15, lines 17-31 of Miyagawa et al. that a controller (i.e., second selector 161) does indeed operate with/is connected to a mechanism (not shown) for detecting rotation of the display device.

Referring to claims 9 and 10, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for modifying the portable information terminal of Miyagawa et al. to include wireless communication and paging capability, as taught by Myer et al., would be to have greater flexibility and mobility of the portable device of Miyagawa et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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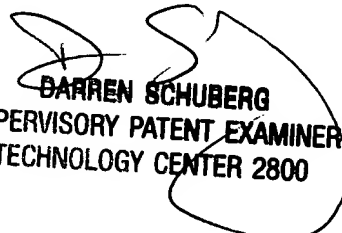
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Q. Edwards whose telephone number is 571-272-2042. The examiner can normally be reached on M-F (7:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 22, 2004
aqe


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